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Paper No. 14
JQ

9/20/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Arcturus Engineering, Inc.

Serial No. 75/393,168

Linda G. Alvarez and Andrew P. Bridges of Wilson Sonsini
Goodrich & Rosati for applicant.

Glenn G. Clark, Trademark Examining Attorney, Law Office
115 (Tomas V. Vlcek, Managing Attorney).

Before Hanak, Quinn and McLeod, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Arcturus Engineering,
Inc. to register the mark CAPSURE for "scientific and
laboratory instruments, namely, transfer film carriers for
use in laser capture microdissection" (in International
Class 9) and "medical instruments, namely, transfer film
carriers for use in laser capture microdissection" (in
International Class 10).¹

¹ Application Serial No. 75/393,168, filed November 19, 1997,
alleging a bona fide intention to use the mark in commerce.

The Trademark Examining Attorney has refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, is merely descriptive thereof.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

The Examining Attorney maintains that the applied-for mark is the phonetic equivalent of the term "capture" and/or a deliberate misspelling thereof. The Examining Attorney argues that the term, as applied to applicant's goods used in laser capture microdissection, merely describes a function or feature of them. In support of the refusal, the Examining Attorney submitted dictionary listings of the term "capture" and an excerpt retrieved from applicant's Web page.

Applicant contends that the mark is just suggestive and that the Examining Attorney has not satisfied his burden to show mere descriptiveness. More specifically, applicant argues that its mark is not the phonetic equivalent of the term "capture," but rather is an inventive triple entendre which merely suggests an indirect connection between applicant's goods and the process with which they are used. Applicant submitted informational

literature on its goods, as well as two articles from trade publications.

The Examining Attorney bears the burden of showing that a mark is merely descriptive of the relevant goods. In re Merrill, Lynch, Pierce, Fenner, and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). A mark is descriptive if it "forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods." Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976) (emphasis added). See also: In re Abcor Development Corp., 616 F.2d 525, 200 USPQ 215 (CCPA 1978). Moreover, in order to be descriptive, the mark must immediately convey information as to the ingredients, qualities or characteristics of the goods with a "degree of particularity." Plus Products v. Medical Modalities Associates, Inc., 211 USPQ 1199, 1204-1205 (TTAB 1981). See also: In re Diet Tabs, Inc., 231 USPQ 587, 588 (TTAB 1986); Holiday Inns, Inc. v. Monolith Enterprises, 212 USPQ 949, 952 (TTAB 1981); and In re TMS Corp. of the Americas, 200 USPQ 57, 59 (TTAB 1978).

Given the descriptiveness refusal and the highly technical function of applicant's goods, it is important to understand the nature of these goods in order to reach an informed decision. The printed materials of record

corroborate the following explanation set forth by applicant:

Laser capture microdissection (LCM) is a revolutionary technology which allows researchers to isolate a single cell or particular cells from a specimen containing perhaps hundreds of different types of cells. The researcher identifies particular cells of interest in a specimen through a specialized microscope which is equipped with a video camera and a laser mechanism. Once the cell or cells which are of interest are identified, the researcher directs the laser at the desired cells within the specimen. The laser melts a highly focused portion of a clear plastic film to which the targeted cells become attached, leaving the remainder of the tissue specimen behind. The plastic film is situated on the underside of a cap which fits directly onto the laboratory tubes which will allow for the subsequent analysis of the cell or cells, resulting in a lesser degree of handling of the targeted cells and a diminished risk of contamination of the specimen. The goods identified by the CAPSURE mark are the combination film carrier-Eppendorf tube cap which allow the transfer of the selected cells to cell digestion reagents with minimal handling and lapse of time.

Applicant contends that the word "capture" communicates only vague information about the goods. We agree with applicant, in any event, that its mark is not likely to be viewed as the phonetic equivalent of the term "capture." We recognize that one of the dictionaries

relied upon by the Examining Attorney shows the pronunciation as "kàp-cher" only, while a listing in another dictionary does show two pronunciations, namely "kap-cher" and "kap-sher." In this connection, however, we note that the applied-for mark, as actually used by applicant, appears as "CapSure." This actual use, which is how purchasers and potential purchasers will encounter the mark, serves to visually and phonetically distinguish the mark from the commonly understood word "capture."

Another significant factor in reaching our decision is the way the mark plays on the respective meanings of "cap," "sure" and "capture." Applicant's argument, which we find persuasive, is as follows:

Applicant's mark, CAPSURE, creates a distinctive triple entendre, playing on the respective meanings of "cap," "sure" and "capture." The "cap" portion of the mark suggests the unique shape of the Applicant's product which enables it to be fitted over the opening of a test tube. The "sure" portion of the mark suggests the idea that one is certain to transfer an uncontaminated sample. Together, the "cap" and "sure" elements create a coined word which, indirectly, conjures up the verb "capture." It does not, however, convey an "immediate idea of [the] ingredients, qualities or characteristics of the goods." [citation omitted] The similarity in sound between CAPSURE and "capture," if anything, suggests an indirect connection between the Applicant's

transfer film carriers and the process
with which they are used--laser capture
microdissection.

In sum, applicant's mark will not be perceived, as the Examining Attorney suggests, as just a misspelled word. Given the meanings pointed to above, applicant's mark has a different commercial impression or connotation from that conveyed by a misspelling of the word "capture." In view of the inventive nature of the mark, being a play on the words "cap," "sure" and "capture," we believe that the meaning or commercial impression of applicant's mark will be more than that simply of the word "capture." See: In re Grand Metropolitan Foodservice Inc., 30 USPQ2d 1974 (TTAB 1994)[MUFFUNS is not merely descriptive of baked muffins]. As applicant points out, registration of the involved mark will not preclude others from making ordinary descriptive use of the term "capture" in connection with other products in the field of laser capture microdissection.

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Decision: The refusal to register is reversed.

E. W. Hanak

T. J. Quinn

L. K. McLeod
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

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